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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte TAIRA HANAOKA and AKIRA SAKAI
11

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13 Appeal 2007-2645
14 Application 09/748,843
15 Technology Center 3600
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19 Oral Hearing Held: February 20, 2008
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23 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
24 FISCHETTI, Administrative Patent Judges

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26 ON BEHALF OF THE APPELLANT:
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35 The above-entitled matter came on for hearing on Wednesday, February 20,
36 2008, at The U.S. Patent and Trademark Office, 600 Dulany Street,
37 Alexandria, Virginia, before Virginia Johnson, Freestate Reporting, Inc.

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P R O C E E D I N G S

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4 MS. HALL: This is Calendar Number 39, Appeal Number 2207-
5 2645 and attorney is Ms. Catherine Vieyra.

6 JUDGE LORIN: Good morning, Counsel.

7 MS. VIEYRA: Good morning. Ready?

8 JUDGE LORIN: You're, you're Miss Catherine Vieyra,
9 V-I-E-Y-R-A.

10 MS. VIEYRA: Correct.

11 JUDGE LORIN: Nice to meet you.

12 MS. VIEYRA: Hi.

13 JUDGE LORIN: We have reviewed the record in Appeal Number
14 2007-2645.

15 MS. VIEYRA: Okay.

16 JUDGE LORIN: You have 20 minutes. When you're ready, you
17 may proceed.

18 MS. VIEYRA: Great, thank you. Okay, our first issue is that the --

19 JUDGE FETTING: Could you speak up a little bit, please?

20 MS. VIEYRA: Sure. The prior art references that the Examiner has
21 cited, Schena and Dougherty, first of all these references do not teach a
22 bookmark image as we recite in our claim. Our invention is a book that
23 includes a bookmark image scanned and stored and then the URL is
24 extracted from this bookmark image and in addition, the user can visit a
25 webpage chosen from the list of bookmarks as our specification discusses on
26 Page 16, Line 11 to 26.

1 You can see we mention in Figure 6 the, the MPU displays a list of
2 bookmark images and then the user can select the bookmark image and then
3 retrieve an associated URL extract. And, then these URL associated with
4 this bookmark image can be extracted. The prior art does not teach or
5 suggest that a user could recall a stored history of scanned links, select a link
6 and access a URL.

7 The prior art of Schena, for example, is not consumer oriented. It's
8 oriented towards provider features so that there's no opportunity for a user to
9 be displaying and manipulating a list. In, in Schena, Column 10, Lines 43 to
10 47, for example, the links, the list of links are stored as and, and transmitted.
11 The receiver may, but not necessarily collect, store and prioritize the
12 transmissions of links and user input information. The receiver collects
13 stored processes and forwards the scanned information. There's no teaching
14 or suggestion in Schena that these links that are collected are available or
15 accessible by the user. There's no teaching that a user of Schena could go
16 back and get into this list of links. These links are -- even when they're
17 saved, they're all saved to do a bulk transmission.

18 And, Schena gives an example of a user finding four advertisements
19 that are related, and then the scanner scans all four, and then all four can be
20 uploaded together. But, there's no teaching, there's no suggestion that a user
21 can look at the list in the way that one would look at bookmarks.

22 Secondly, we, we -- our claims recite displaying an image stored in
23 memory as a bookmark image associated with a URL or associated with
24 Claim 1 recites access destination location and Claim 6 recites contents
25 locating information. In contrast, in Schena, the most that he stores is the
26 list of links. This -- these links are monolithic. They could include, for

1 example, a URL or an internet address.

2 He gives a list of the links Schena at Column 2, Line 66 to Column
3 through line 7. So, that Schena has perhaps a list of access destination
4 locations, but he does not have displaying a bookmark image associated with
5 the access information or associated with the content locating information.

6 Schena does not teach, suggest, display or even creating images and
7 links. He is just collecting the links and perhaps user information, but the
8 user information is not a link nor a description of the link. And it's not an
9 image. His user information is advertising information, transaction and
10 authorization, user personal profile information as discussed in Column 15,
11 Lines 36 through 39. Further, Schena's collection of links provide access to
12 multimedia information, not necessarily to a webpage. Column 2, Line 37 to
13 46, Schena says the portal server receives the link information and user input
14 information and selects multimedia information sequence corresponding to
15 the link information and the user input.

16 Third, our third point, our third issue is that the combination of
17 Schena and Dougherty is not appropriate. Dougherty is directed to improve
18 the human computer interface by providing printable interfaces that enable a
19 user to invoke and control computer processes. Dougherty is actually
20 addressed to creating the media that Schena discusses. The printed media
21 then could be scanned and accessed. So, Dougherty talks about multicon,
22 linkmark, icons, but these icons are encoded and they're machine readable.
23 They're not bookmark images that would be displayed on the screen for a
24 user.

25 JUDGE FETTING: But aren't -- isn't, isn't it really just a bookmark
26 image that's on a printed page or on a tee-shirt or something as opposed to

1 being on the screen in that it contains the information that is necessary and
2 in fact, Dougherty actually says it is able to actually connect to that link. In
3 other words, in Dougherty, once it, once it scans in the multicon link, it, it, it
4 extracts the link information and it actually executes that link.

5 MS. VIEYRA: Yes.

6 JUDGE FETTING: It just happens scanning in from a printed page
7 rather than off of a computer screen.

8 MS. VIEYRA: But you wouldn't have a whole list of bookmarks
9 like we have.

10 JUDGE FETTING: I'm sorry --

11 MS. VIEYRA: Choose one from the list.

12 JUDGE FETTING: -- I don't see the list of bookmarks in Claim 1.

13 MS. VIEYRA: Well -- so, I mean, but we're claiming displaying the
14 image stored in memory as a bookmark image.

15 JUDGE FETTING: And, that's the distinction. Dougherty, the
16 image is on a piece of paper or a tee-shirt, not on the, not stored.

17 MS. VIEYRA: Right, and it's not stored and it's encoded differently,
18 but, but --

19 JUDGE FETTING: Well, certainly, certainly --

20 MS. VIEYRA: --we don't claim that, okay --

21 JUDGE FETTING: -- it's encoded. I mean --

22 MS. VIEYRA: -- but, it's not stored and it's not displayed --

23 JUDGE FETTING: It's not displayed. Certainly, certainly

24 MS. VIEYRA: -- on -- right, it's not stored and displayed --

25 JUDGE FETTING: the image is encoded within the images --

26 MS. VIEYRA: Right, but, I mean, it's not stored. It's not stored in

1 the memory. It's not displayed on, you know --

2 JUDGE FETTING: Right, so, this is a 103, the obvious question is
3 what's the difference between having it on a tee-shirt and having it on a
4 computer screen other than it'd probably be easier to execute from the
5 computer screen than from the tee-shirt.

6 MS. VIEYRA: Okay, but why would you
7 combine -- but, it's, it's the -- he's the precursor of Schena. Why would you
8 take what he's doing in advance and stick it in at the end. Where is the
9 suggestion of doing that. His, his invention -- Dougherty's invention is the
10 ad, the advertisement that Schena talks about, hey, you read the newspaper
11 and you scan this advertisement, and, and that's --

12 JUDGE FETTING: As, as a way of --

13 MS. VIEYRA: -- what Dougherty is. And, that's how -- and
14 Dougherty is telling you how to make that.

15 JUDGE FETTING: Right.

16 MS. VIEYRA: How does that and then you would use that then
17 Schena uses that. He creates linklist. We actually use that also. We use that
18 and we create bookmarks for someone to go back later so that they can have
19 this whole list. So, we are -- Dougherty is not -- there's no suggestion of
20 taking Dougherty's precursor concept and saying, oh look, let's stick it in
21 the end here. Let's, let's take his precursor which we're using. That's how
22 we're getting our data from our ads. And, now, okay, hey now that I think
23 of it, I'm going to put it in the end to make a bookmark. There's no, there's
24 no teaching of that in part because Schena and Dougherty they're not
25 concerned with users. They're not concerned with consumer orientation.
26 This is -- these things are all kind of earlier than that. They're, they're not at

1 all concerned with that. They're concerned with what's the best way I can
2 do an ad and make money off my ad and from the advertiser's point of view.
3 So, they're not at all thinking about, let's help it and make it more consumer
4 friendly. So, then where would be a motivation that, you know, that could
5 have been a motivation, but that's not there. They don't care. So, they --
6 there's no motivation to take this whole thing and say, oh, by the way, this
7 would make a cool bookmark, let's stick it in as a bookmark. That's our
8 argument.

9 JUDGE FETTING: Okay.

10 MS. VIEYRA: And, finally, of course, the -- our argument is that he,
11 that they display the bookmark image with the information. Even if
12 Dougherty, even with Dougherty's display, he doesn't display the image and
13 the information. He just has a display that you can scan and pick-up. And, I
14 guess that would be our -- that there's not really a motivation for combining
15 them in that way to -- we, you know, there's, they're, they're not really this -
16 - Dougherty isn't really a bookmark because it's printed. And, there's no
17 motivation to take Dougherty's features which are already kind of there and
18 put them in to make this consumer oriented bookmarking device. Okay.

19 JUDGE FETTING: Okay.

20 MS. VIEYRA: That's pretty much it.

21 JUDGE LORIN: You have any questions?

22 JUDGE FISCHETTI: No.

23 JUDGE FETTING: No further questions.

24 MS. VIEYRA: Okay.

25 JUDGE LORIN: Thank you, Counsel, we'll take your comments
26 under advisement.

- 1 MS. VIEYRA: Great, thank you.
- 2 (Whereupon, the proceedings concluded.)